

120

4-22-04

1 AP 3654

DURIO, McGOFFIN, STAGG & ACKERMANN

ATTORNEYS AND COUNSELORS AT LAW
PROFESSIONAL CORPORATIONS

STEVEN G. DURIO
GARY McGOFFIN
WILLIAM W. STAGG*
JEFFREY ACKERMANN
JAMES R. SHELTON

OF COUNSEL:
GENE BROUSSARD



220 HEYMANN BOULEVARD
P.O. BOX 51308
LAFAYETTE, LOUISIANA 70505-1308
337-233-0300
FAX 337-233-0694

*ALSO CERTIFIED TO PRACTICE BEFORE
THE U.S. PATENT OFFICE OR IN OTHER STATES

DANIEL C. PALMINTIER
ROBERT L. BROUSSARD
JACQUES E. deMOSS*
TIFFANY B. THORNTON
RANDALL M. GUIDRY
JULIETTE BUSBY WADE
SHAWN A. CARTER

April 20, 2004

Via Express Mail #ER 521294564 IIS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: George C. Jeane
Serial No.: 10/068,695
Filed: February 5, 2002
For: "Flipping and Pitching Reel"

LETTER OF TRANSMITTAL

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
APR 27 2004
GROUP 3600

Dear Sir:

Enclosed is the Appeal Brief, in triplicate, on behalf of Appellant, George Jeane in the above identified application.

Also enclosed is a U.S. Postal Service Money Order in the amount of \$165.00 to cover the fees for the Notice of Appeal.

Please acknowledge receipt of the above documents by date stamping the enclosed postcard and returning same to the address on the reverse side.

With kindest regards, I am

Very truly yours,

William W. Stagg
Reg. No. 31,225
Attorney for Applicant

WWS/lmk

Enclosures: Appeal Brief, in triplicate
U.S. Postal Money Order in the amount of \$165.00
Return Receipt Postcard

cc: Mr. George Jeane

www.jeane/patent-advice/pto-4185686

CERTIFICATE OF MAILING

I, Lucinda M. Kennedy, certify that the foregoing Appeal Brief, in triplicate, and Money Order in the amount of \$165.00 is being deposited with the U.S. Postal Service by Express Mail (#ER 521294564 US) addressed to Mail Stop Appeal Brief - Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of April, 2004.



LUCINDA M. KENNEDY



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

RECEIVED
APR 27 2004

GROUP 3600
#10
P. Allen
04/28/04

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Application of George Jeane

Serial No.: 10/068,695

Filing Date: 02/05/02

Examiner: Langdon, Evan H.

Art Unit: 3654

For: Flipping and Pitching Reel

BRIEF FOR APPELLANTS

This is an appeal from the Examiner of Art Unit 3654 refusing Claims 1, 3-19, and 21-36, all of the Claims in the case. Claims 1, 3-19, and 21-36 are the subject of this appeal. The Claims on appeal are attached hereto as Appendix A.

Related Appeals and Interferences

There are no related appeals or interferences known to the appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Boards' decision in the pending appeal.

Status of the Claims

Claims 1, 3-19, and 21-26 are currently pending in the application. Claims 2 and 20 were previously cancelled. Claims 1-4, 21 and 22 were rejected under 35 U.S.C. § 102(b), as they were thought to be anticipated by Shumate et al. Claims 5-7, 11, 13-17, 23 and 24 were rejected under 35 U.S.C. 103(a), as they were thought to be unpatentable over Shumate et al. in view of Zwayer et al. Claims 8-10, 18, 19, 25 and 26 were also rejected under 35 U.S.C. 103(a) as being unpatentable over Shumate et al. in view of Shakespeare. Claims 1, 3-19, and 21-26 are the subject of this appeal.

04/23/2004 HVDNG1 00000012 10068695

01 FC:2402

165.00 OP

Status of Amendments

Applicant has not filed any Amendments subsequent to the Examiner's Final Action rejecting Claims 1, 3-19, and 21-26. Claims 1, 3-19, and 21-26 as previously amended are the subject of this appeal. A copy of all of the Claims, as amended are included in *Appendix A* which is attached hereto.

The References Relied Upon

Shakespeare	1,869,441	Aug. 1932	242/310
Shumate et al.	3,784,124	Jan. 1974	242/297
Zwayer et al.	6,070,822	Jun. 2000	242/310

Summary of the Present Invention

The present invention provides a revolving spool bait casting type reel utilized for casting a fishing lure attached to the end of a fishing line in the conventional overhand manner. The reel is adapted to facilitate use of the reel when underhand casting techniques, commonly called flipping and pitching, are employed by the user. Applicant's reel incorporates a stationary, centrally situated, line guide mounted on the reel in a manner to position the fishing line directly onto a uniquely configured revolving spool that retains the fishing line. The reel may further include conventional drag and spool-braking systems common on revolving spool bait casting reels.

Figure 1 of Applicant's drawing illustrates a perspective view of Applicant's fishing reel (10) shown mounted on a longitudinally extending casting rod (30). The reel (10) is comprised of a frame (11) having a line guide support (13), line guide (15) and revolving cylindrically shaped spool (20). The cylindrical spool (20) is has a line-holding

channel (26) of a substantially rectangular cross-section formed in its center for holding a length of coiled fishing line (28). The revolving spool (20) is positioned on the reel (10) so that when the reel (10) is mounted on the rod (30), the axis of rotation of the spool (20) is transverse to the longitudinally extending rod (30). The reel (10) has a spooling mechanism (16) comprised of a handle, spool drag, spool release and spool braking mechanisms that is used to control rotation of the spool (20). Fishing line (28) is coiled onto and distributed from the channel (26) of the cylindrical spool (20) as the spool (20) revolves during the casting and reeling in of a fishing lure.

A side elevation view of the reel (10) is depicted in Figure 2 and a front elevation view of the fishing reel (10), shown from line 3-3 of Figure 2, is displayed in Figure 3. The stationary line guide (15) is positioned on the line guide support (13) so as to place the line guide (15) in front of and in line with the middle of the line-holding channel (26) formed in the center of the spool (20). In Figure 3, the line guide (15) is shown as a vertically extending elongated ring, the width of which is less than the width of the line-holding channel (26) and the length of which is less than the depth of the line-holding channel (26).

It is thought that line tangling and backlash will be minimized when the vertical dimension of the line guide (15) is kept in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the depth of the line channel (26) and the width of the line guide (15) is kept in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the line channel (26). It is also thought that the line will be distributed more readily from the line-holding channel (26) of the revolving spool (20) when the line guide (15) is positioned on the line guide support (13) so as to place its vertical mid-point no lower than approximately the vertical mid-point of the line-

holding channel (26) and no higher than approximately the top rim of the line holding channel (26).

Figure 4 illustrates an alternative embodiment of Applicant's fishing reel designated as (10a) mounted on a casting rod (30). In the alternative embodiment, the reel (10a) has a circularly configured, stationary line guide (15a) positioned on line guide support (13a) of reel frame (11a) so as to center the line guide (15a) in front of and in line with the middle of the substantially rectangular line-holding channel (26) formed in the center of the spool (20). The circular line guide (15a) has a diameter X, designated as (12a), that is less than the width of the line-holding channel (26). It is thought that the keeping the diameter X of the line guide (15a) in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the line channel (26) will be suitable for Applicant's reel and will minimize the incidence of backlash and line tangling while casting with the pitching and flipping methods described herein.

Applicant has also found that when the diameter X, designated as (12a), of the line guide (15a) is approximately $\frac{3}{16}$ inches and the width of the line channel (26) is approximately $\frac{11}{32}$ inches, the incidence of line backlash and tangling during casting of a lure by the pitching and flipping methods described with a reel (10 a) according to Applicant's invention will be further minimized.

Figure 5 shows a cross-sectional view of the fishing reel (10a) cut on line 5-5 of Figure 2. From this view, the rectangular shaped line-holding channel (26) is shown centrally positioned on the spool (20) for retaining a quantity of coiled fishing line. The spool (20) is supported by spool hub (24) that is attached to the transversely extending spool axel (18) that is rotatably mounted on reel frame (11), the rotation of the spool

(20) being controlled by the cranking mechanism (16).

The line-holding channel (26) of the spool (20) is configured in a substantially rectangular cross-section to allow the fishing line (28) stored around the line-holding channel (26) to be coiled and stacked as the spool (20) is revolved. The substantially rectangular configuration of the channel (26) allows the coiled fishing line (28) to be distributed from the spool (20) uniformly as the spool (20) revolves to discharge the line (28) during a cast.

The circular line guide (15) shown in Figure 5 has a width Y, designated as (14), that is less than the width of the line-holding channel (26). It is thought that the keeping the width Y of the line guide (15) in the range of about 3/8 to about 5/8 of the width of the line channel (26) will be suitable for Applicant's reel and will be sufficient to reduce the incidence of line backlash and tangling commonly associated with employing pitching and flipping casting methods with revolving spool casting reels.

Figure 6 is a cross-sectional view of the fishing reel (10) cut on line 6-6 of Figure 3. This view illustrates the location of the guide (15) with respect to the spool (20). The guide (15) is positioned forward of and upward from the axel (18) of the spool (20) to guide the line (28) onto the line channel (26). Applicant has found that maintaining the mid-point of the guide (15) at a point no lower than approximately the vertical mid-point of the line-holding channel (26) and no higher than approximately the rim of the line-holding channel (26) will enhance performance of the reel (10) during casting.

Issues

1. Are Claims 1-4, 21 and 22 properly rejected under 35 U.S.C. § 102 as being unpatentable over Shumate et al.

2. Are Claims 5-7, 11, 13-17, 23 and 24 properly rejected under 35 U.S.C. § 103 as being unpatentable over Shumate et al. in view of Zwayer et al.
3. Are Claims 8-10, 18, 19, 25 and 26 properly rejected under 35 U.S.C. § 103 as being unpatentable over Shumate et al. in view of Shakespeare.

Argument

- 1. Are Claims 1-4, 21 and 22 properly rejected under 35 U.S.C. § 102 as being unpatentable over Shumate et al.**

The Examiner rejected Claims 1-4, 21 and 22 under 35 U.S.C. § 102(b) as they were thought to be anticipated by Shumate et al. Note that Claim 1 was previously amended to include the limitations of Claim 2 and Claim 2 was previously cancelled.

Claims 1, 3-4 and 21 and 22, were rejected by the examiner under 35 U.S.C. § 102(b) as they were thought to be anticipated by Shumate et al. The examiners basis for rejection of the claims is set forth below:

Shumate et al. was thought to disclose a fishing reel comprising:

a frame 19 having forward and reward ends and two sides, Shumate et al. Figures 1 and 2; a transversely orientated, *revolvable* cylindrical spool 23 mounted to frame 19 and a recessed channel 25 for holding a length of fishing line; a line guide 22 mounted to the frame in a fixed position forward of the spool; and means 29 for controlling the rotation of the spool and dispensing fishing line from the channel 25 as the spool 23 rotates during the casting of the fishing lure and onto the channel of the spool during retrieval of the fishing lure as the spool rotates during casting of the fishing lure.

In regards to claim 3, Shumate shows the channel 25 is substantially rectangular cross-section.

In regards to claim 4, Shumate shows the vertical mid-point of the line guide 22 positioned so as to be no lower than approximately the vertical mid-point of the recessed channel and no higher than approximately the top rim of the recessed channel, as seen in Figure 2.

In regards to claim 21, Shumate shows a fishing comprising:

a frame 19 and a means for mounting the frame on a longitudinally extending fishing rod, as seen in Figures 1 and 2;

a revolving cylindrical spool 23 mounted to the frame 19 and positioned so that the spool's axis of rotation is transverse to the longitudinally extending fishing rod and a recessed channel 25 of substantially rectangular cross-section, being narrow in depth and centered in the transverse axis;

a ring-shaped line guide 22 mounted on the frame in a fixed position forward of the spool; and

means for releasing the spool and dispensing the fishing line from the channel 25 as the spool rotates during the casting of the fishing lure; and

means 29 for coiling line onto the channel of the spool during retrieval of the fishing line.

In regards to claim 22, Shumate shows the vertical midpoint of the line guide 22 is positioned so as to be no lower than approximately the vertical mid-point of the recessed channel and no higher than approximately the top rim of the recessed channel, as seen in Figure 2.

MPEP § 2131 states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. [Citation Omitted] The identical invention must be shown in as completed detail as contained in the ... claim. [Citation Omitted] The elements must be arranged as required by the claim."

Applicant's Claim 1, and the succeeding dependent claims, have as limitations:

1. A fishing reel, comprising:
 - a. a frame, said frame having forward and rearward ends and two sides;
 - b. a transversely orientated, revolvable cylindrical spool mounted to said frame, said spool having a recessed channel for holding a length of coiled fishing line; and
 - c. a line guide mounted on said frame in a fixed position forward of said spool; and
 - d. means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure.

It is respectfully suggested that each and every element of Claim 1 and is not disclosed in Shumate et al. For example Claim 1 has the limitation "means for

controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure.” The reference cited by the examiner for this limitation is the crank 29 of Shumate. (See Figure 1 and 2, and Col. 1, line 67 – Col. 2 line 2).

A cast is defined as to throw or fling.¹ The structure, crank 29, cited by examiner as the controlling means is inherently incapable of providing means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure. This is because the crank 29 is intended to lower the line and retrieve the line much like a winch. It can provide no control during casting because as the spool rotates so does the crank in Shumate. If the spool 29 is held, the spool of Shumate must stop rotating. Consequently, there is no control imparted by the crank 29 as the spool rotates during the casting of a fishing lure.

Further, it is respectfully suggested the Shumate et al. does not suggest casting in the sense of the reel claimed by Applicant's claim one. Shumate make only an illusory reference to casting. This is at Col. 2, lines 28 –30, where it is noted “Even though the reel is not designed for use in casting, it can be used for short distances, by using it is a fly rod or by using a heavy weight for bottom fishing.” The reel of Shumate would not function as a “fly rod” as described. Apparently Shumate is suggesting its use a “fly reel”. It is respectfully suggested that it is common knowledge that the spools

¹ 2cast n 1 : THROW, FLING. (c)2000 Zane Publishing, Inc. and Merriam-Webster, Incorporated.
All rights reserved.

of fly reels do not rotate in the casting of the lure. As to the suggestion of "bottom fishing" the lure is dropped, not "cast", to the bottom in the manner of a winch. Consequently, the claimed limitations are not disclosed by Shumate. In fact, a "fly reel" would teach away from Applicant's claim 1 because such reels do not rotate during casting. Considering the foregoing, it is respectfully suggested the Shumate et al. does not teach each and every limitation of Applicant's claim 1 and its succeeding dependant claims.

With regard to claim 3 and 21, it is respectfully suggested that Shumate does not show a cylindrical spool having a channel as defined by Applicant. It is well settled that the Applicant is his own lexicographer. Applicant has defined his spool to be "a centrally positioned line storage area on the reel spool" (Applicant's specification, page 3, line 16 – 17). The line-holding channel (26) of the spool (20) is configured in a substantially rectangular cross-section so as to allow for the fishing line (28) stored around the line-holding channel (26) to be coiled and stacked as the spool (20) is revolved. (Applicant's specification, page 7, line 5 - 7). The spool of Shumate et al. has no such defined "channel".

As shown in Figure 2, the line holding area 25 of the spool 14 of Shumate is in essence comprised of the entire width of the spool 14. Further, as shown and described in Shumate at Col. 1, lines 61 – 66, the spool 14 is comprised of a central cylindrical drum 23 having a flat radially outwardly extending flange 24 at each end thereof so as to form a space 25 there between and within in which the fishing line is wound upon the drum. Consequently, there is no distinct line holding area as claimed by Applicant, rather the spool itself forms the line holding area. When taking the

definition of the "recessed area" as defined in Applicant's specification, it is respectfully suggested that Shumate does not disclose each and every limitation of Applicant's claim 1, 3 or 21.

With regard to claim 4 and 22, it is suggested that in making a 35 U.S.C. 102(b) analysis, the subject matter of each claim as a whole must be taken into consideration and to do so affirmatively involves taking into account all of the limitations of a particular claim. In this case, Claims 4 and 22 must be considered to have all of the limitations of their base claim and any intervening claims. When these limitations are considered, the cited reference does not suggest or disclose the claimed combination. It is respectfully suggested that focusing on the shape of the line guide alone or on the shape of the spool alone would be an improper interpretation of the claim. The claim must be read as a whole and each of the limitations must be considered. When this is done the additional limitations, such as the "means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure" would prevent rejection under 35 U.S.C. § 102(b). There is nothing in Shumate that discloses or even suggests each and every limitation of Applicant's Claims or all the limitations of the base claims and any intervening claims. From the foregoing it is respectfully suggested that Claims 1, 3-4 and 21 and 22 are not anticipated, disclosed or suggested by the disclosure of Shumate and Applicant requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

2. Are Claims 5-7, 11, 13-17, 23 and 24 properly rejected under 35 U.S.C. § 103 as being unpatentable over Shumate et al. in view of Zwayer et al.

Claims 5-7, 11, 13-17, 23 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shumate et al. in view of Zwayer et al.. With respect to Claims 5, 13 and 23, it was thought by the Examiner that Shumate et al. failed to show the ring guide member as being substantially circular, while Zwayer taught a ring guide member being circular in shape and that is smooth to reduce friction and snaps into place. The Examiner thought that it was obvious to one skilled in the art at the time the invention was made to modify the ring guide of Shumate to include a circular shape as suggested by Zwayer et al., to reduce friction and minimize backlash.

In response to the rejections of Claims 5, 13 and 23 as being unpatentable under 35 U.S.C. 103 (a) over Shumate et al. in view of Zwayer et al., Applicant respectfully asserts that there would have been no motivation to combine Shumate and Zwayer to make the claimed invention. MPEP §2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. ...If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (Citations omitted, emphasis in original)."

Shumate and Zwayer address problems that are different from that solved by the present invention, and that are also very different from one another. A person of ordinary skill in the art would not have combined their teachings. Shumate, the primary reference cited by the Examiner, discloses a reel having a transversely orientated, cylindrical spool

mounted to the frame, a channel for holding a length of fishing line, a means for positioning the fishing line onto the channel and a means for controlling the rotation of the spool. Zwayer, the secondary reference cited by the Examiner, discloses a ring guide member being circular in shape and is smooth to reduce friction. Shumate never suggests the use of a ring guide member, circular or otherwise. By contrast, one embodiment of Shumate discloses an "opening" in the side of the cylindrical wall of the case in order to distribute the fishing line. Thus, while two patents may have similar purposes (i.e., fishing reels), there would have been no motivation to combine Shumate and Zwayer to produce the fishing reel that has a spool that continuously revolves during casting and prevents "backlash".

As MPEP §2143.01 confirms, an invention is not obvious merely because different components of the invention may be found somewhere in different pieces of prior art. With the benefit of hindsight, essentially all inventions may be viewed as being composed of old parts, arranged in a new way. But an invention is not obvious unless the prior art provides some motivation to make the proposed combination of old parts, with a reasonable expectation of success. Here, there was none. There would have been no motivation for a person of ordinary skill in the art to combine a reference concerning a cane pole fishing reel, which is intended to eliminate the necessity to wind the line around the pole so to shorten or unwind the line, with a reference that relates to hook keepers for spincast fishing reels. Neither reference suggests a fishing device that is designed to prevent backlash. To the contrary both Shumate and Zwayer teach devices that specifically do not address the problem of backlash. Thus, Shumate and Zwayer teach away from the present invention. Teaching away from an invention is the antithesis of obviousness.

Considering the foregoing, it is respectfully suggested that Shumate et al. and Zwayer et al. do not teach each and every limitation of Applicant's Claims 5, 13 and 23, as amended, and furthermore there is no motivation to combine their teachings and thus do not serve as proper references under 35 U.S.C. § 103(a) to support a rejection.

With respect to Claims 6, 11, 14, 16 and 24 it was thought by the Examiner that Shumate et al. as modified by Zwayer et al. did not disclose specific values for the diameter of the line guide and the width of the line channel. However, the examiner thought that one of ordinary skill in the art is expected to routinely experiment with the parameters specifically when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use and that it would have been no more than a matter of obvious engineering design choice to select the claimed ranges. In response to this rejection Applicant respectfully suggests that one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather one must consider what one might be led to do in light of the prior art. It is respectfully suggested that neither Shumate nor Zwayer considers the line guide dimensions or position as a potential remedy for controlling "backlash" in a spool that revolves during the cast. Nothing in Shumate et al. or Zwayer et al. even suggests that the spool revolves during the casting of a lure or even address the problem of backlash.

Applicant also respectfully suggests that all of the limitations of the claims must be considered and that the claims, as amended, are not suggested by Shumate et al. or Zwayer et al.. It is suggested that it would be incorrect to focus the §103 inquiry on a particular limitation or on the "gist" of the invention relative to prior art. The differences between the claims and the cited references must be considered. See *In re Gulack*, 703 F.

2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). When these limitations are considered, the cited references do not suggest or disclose the limitations of Applicant's Claims.

Considering the foregoing it is respectfully asserted that Claims 5-7, 11, 13-17, 23 and 24 as now amended, are not suggested or disclosed by the cited references and Applicant respectfully requests that the rejection of these Claims under 35 U.S.C. 103(a) be withdrawn.

3. Are Claims 8-10, 18, 19, 25 and 26 properly rejected under 35 U.S.C. § 103 as being unpatentable over Shumate et al. in view of Shakespeare.

Claims 8-10, 18, 19, 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shumate et al. in view of Shakespeare. The Examiner noted that in regards to Claims 8, 18, and 25, Shumate et al. failed to show the ring guide member as being a substantially vertically extending elongate ring. However, the Examiner thought that Shakespeare taught a ring guide member shaped as an elongated endless guide eye having an improvement over the prior art wherein the line guide eye provides a rounded wear surface to the line and press fits to the frame.

The Examiner was of the opinion that it was obvious to one of ordinary skill in the art at the time the invention was made to modify the ring guide of Shumate to include a substantially vertically extending elongate ring shape as suggested by Shakespeare, in order to reduce friction and minimize backlash.

In response, to the rejection of Claims 8, 18 and 25 as being unpatentable under 35 U.S.C. § 103(a) over Shumate et al. in view of Shakespeare, Applicant again respectfully asserts that there would have been no motivation to combine Shumate and Shakespeare to

make the claimed invention. When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification. *Motorola Inc. v. Interdigital Technology Corp.*, 43 U.S.P.Q. 2d 1481 (CAFC 1997); *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q. 2d 1941, 1943 (Fed. Cir. 1992) (stating that there must be some suggestion to combine, "either in the references themselves or in the knowledge generally available to one of ordinary skill in the art"); *see Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 292, 227 U.S.P.Q. 657, 664 (Fed. Cir. 1985).

As noted above, the line guide of Shumate is not adjustable so as to allow it to be fixedly positioned between the vertical mid-point of the channel and no higher than the rim of the channel. Rather the line guide of Shumate is simply an "opening" in the cylindrical side wall, fixed in a constant position. See Shumate et al. at Col. 1, lines 56-60. In Shakespeare, the secondary reference cited by the Examiner, the elongated endless guide eye as shown in Figure 1 and Figures 3-4 is of a shape corresponding to the opening of the casing and is longitudinally curved. See Shakespeare at Col. 1, lines 47-50. Nothing in Shakespeare suggests that a stationary elongated line guide, in the absence of the level wind system, would serve to reduce or eliminate backlash during casting. As mentioned earlier, an invention is not obvious merely because different components of the invention may be found somewhere in different pieces of prior art. There must be some motivation to make the proposed combination of old parts, with a reasonable expectation of success. Neither Shumate et al. or Shakespeare suggest a fishing reel that contains a substantially rectangular channel which allows coiled fishing line to be distributed from the spool

uniformly as the spool revolves to discharge the line during a cast, while also preventing backlash.

There is nothing in Shumate et al. or Shakespeare that would motivate an ordinary person skilled in the art to combine their teachings to create the device claimed by the applicant. The line guide of Shakespeare is designed for a purpose that is substantially different from the purpose of the claimed invention of the applicant. The line guide of Shakespeare was designed to prevent wear on the line as it played back and forth on the spool and to provide an attractive finish. See Shakespeare Col 1, lines 1 - 5 and 96 -99. It is the position of the line guide as a means to prevent line wear, not the width or length of the guide as a means for controlling backlash, with which Shakespeare is concerned. Consequently, adjustments in the line guide dimensions or the width of the line spool as it relates to the "elongated" guide of Shakespeare would not be an ordinary concern or an indication for experimentation for engineering design choices.

With regard to Claims 9, 19 and 26, the Examiner noted that Shumate et al. as modified by Shakespeare did not disclose specific values for the line guide diameter or channel width. However, it was thought that one of ordinary skill in the art would routinely experiment with these parameters so as to ascertain the optimum or workable ranges for a particular use.

With regard to the claimed specific value limitations for the line guide diameter or channel width, Applicant re-argues that all of the limitations of the claims must be considered and that the claims, as amended, are not suggested by Shumate as modified by Shakespeare. The differences between the claims and the cited references must be considered. See *In re Gulack*, supra. When these limitations are considered, the cited

references do not suggest or disclose the limitations of Applicant's Claims. Nothing in the cited prior art suggests a relationship between the dimensions of the line guide and the dimensions of the spool width as a means for controlling "backlash" or line tangling. Consequently, there is no suggestion that experimentation in this area would be indicated or suggested as a basis to pursue a solution to line tangling or "backlash."

Applicant respectfully suggests that the test is not "obvious to try" such design choice but "obvious to do" these choices. Since the cited references do not disclose or even suggest the claimed relationships between the line guide dimensions and spool channel width, which are key structural elements of these claims and that as such cannot be ignored, there is no indication that alteration of the relationships would be obvious to a person ordinarily skilled in the art to which the invention pertains as a means to control backlash and line tangle and therefore there is no basis for rejection of Claims 9, 19 and 26, as may be amended, under 35 U.S.C. § 103(a). See *In re Clinton*, 527 F.2d 1226, 168 U.S.P.Q. 365 (CCPA 1976); *In re Antonie*, 559 F. 2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977) and *In re Gulack*, 703 F. 2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). Therefore the Applicant respectfully submits that the rejection of Claims based on 35 U.S.C. 103 be withdrawn.

Conclusion

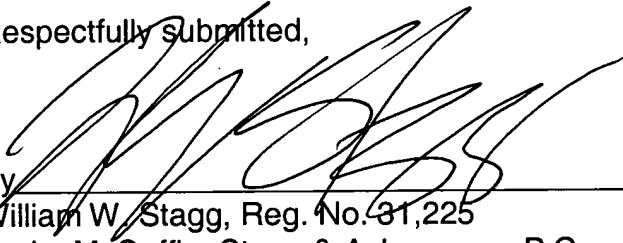
It is the Applicant's position that none of the references cited by the Examiner in his Final Action rejecting all of the Applicant's Claims were applicable and dispositive. Shumate et al. proposes an "opening" in the cylindrical side wall of the case that serves to dispense and rewind the fishing line. In Zwayer et al., the line guide is simply a

circular opening in the cone piece of the cover assembly, while Shakespeare suggests the use of either a circular opening or elongated eye guide. The eye guide in Shakespeare only purports to decrease the wear and tear of the spool string in the process of casting and reeling in.

These teachings are directly in opposite to the suggested teachings of the Applicant. The Applicant's invention specifically addresses the problem of backlash, which is not mentioned either expressly or implicitly in the references cited by the Examiner. As a result, it is respectfully suggested that these references are not properly combinable to provide prima facie rejections of Claims 1, 3-19, and 21-26, the Claims on appeal.

For the foregoing reasons the Applicant respectfully submits that the rejection of Claims 1, 3 -19 and 21-26 should be withdrawn and the claims allowed to issue.

Respectfully submitted,



By
William W. Stagg, Reg. No. 31,225
Durio, McGoffin, Stagg & Ackermann, P.C.
P.O. Box 51308
Lafayette, LA 70505
(318) 233-0300; Fax (318) 233-0694
Attorney for Applicants

Appendix A

1. A fishing reel, comprising:
 - a) a frame, said frame having forward and rearward ends and two sides;
 - b) a transversely orientated, revolvable cylindrical spool mounted to said frame, said spool having a recessed channel for holding a length of coiled fishing line; and
 - c) a line guide mounted on said frame in a fixed position forward of said spool; and
 - d) means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure.
2. (cancelled)
3. The fishing reel according to claim 1 wherein, said recessed channel of said spool has a substantially rectangular cross-section.
4. The fishing reel according to claim 3 wherein, the vertical mid-point of said line guide opening is positioned so as to be no lower than approximately the vertical mid-point of said recessed channel and no higher than approximately the top rim of said recessed channel.
5. The fishing reel according to claim 4 wherein, said line guide is substantially circular.

6. The fishing reel according to claim 5 wherein, the diameter of said substantially circular line guide is in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of said channel.
7. The fishing reel according to claim 6 wherein, the center of said substantially circular line guide is positioned no lower than approximately the vertical mid-point of said channel and no higher than approximately the rim of said channel.
8. The fishing reel according to claim 4 wherein, said line guide is a vertically extending elongated ring.
9. The fishing reel according to claim 8, the width of said elongated ring line guide being in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the said channel and the length of said elongated ring line guide being in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the depth of said channel.
10. The fishing reel according to claim 9 wherein, the mid-point of said elongated ring line guide is fixedly positioned no lower than approximately the vertical mid-point of said channel and no higher than approximately the rim of said channel.
11. The fishing reel according to claim 5 wherein, said line guide is approximately $\frac{3}{16}$ inches in diameter and said line channel is approximately $\frac{11}{32}$ inches in width.

12. The fishing reel according to claim 11 wherein, the center of said line guide is positioned no lower than approximately the vertical mid-point of said channel and no higher than approximately the rim of said channel.

13. A fishing reel, comprising:

- a) a frame, said frame having forward and rearward ends and two sides;
- b) a transversely orientated, revolvable cylindrical spool mounted to said frame, said spool having a recessed channel of a substantially rectangular cross-section for holding a length of coiled fishing line; and
- c) a circular line guide fixedly mounted on said frame forward of said spool for positioning said fishing line onto said channel of said spool, the center of said line guide positioned so as to be in alignment with the vertical mid-point of said recessed channel; and
- d) means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casting of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure.

14. The fishing reel according to claim 13 wherein, the diameter of said line guide is in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of said channel.

15. The fishing reel according to claim 14 wherein, the center of said line guide is positioned no lower than approximately the vertical mid-point of said channel and no higher than approximately the rim of said channel.

16. The fishing reel according to claim 13 wherein, said line guide is approximately $\frac{3}{16}$ inches in diameter and said line channel is approximately $\frac{11}{32}$ inches in width.

17. The fishing reel according to claim 16 wherein, the center of said line guide is positioned no lower than approximately the vertical mid-point of said channel and no higher than approximately the rim of said channel.

18. A fishing reel, comprising:

- a) a frame, said frame having forward and rearward ends and two sides;
- b) a transversely orientated, revolvable cylindrical spool mounted to said frame, said spool having a recessed channel of a substantially rectangular cross-section for holding a length of coiled fishing line; and
- c) a line guide fixedly mounted on said frame forward of said spool for positioning said fishing line onto said channel of said spool, said line guide being configured as a vertically extending elongated ring, the vertical mid-point of said elongated ring positioned so as to be no lower than approximately the vertical mid-point of said recessed channel and no higher than approximately the top rim of said recessed channel; and

- d) means for controlling the rotation of said spool and thereby dispensing said fishing line from said channel as said spool rotates during the casing of a fishing lure and on to said channel as said spool rotates during retrieval of said fishing lure.

19. The fishing reel according to claim 18 wherein, the width of said elongated ring line guide being in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the said channel and the length of said elongated ring line guide being in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the depth of said channel.

20. (cancelled)

21. A bait casting reel for casing a fishing lure comprising:

- a) a frame;
- b) a means for mounting said frame on a longitudinally extending fishing rod;
- c) a revolving cylindrically shaped spool mounted on said frame, said spool being positioned on said frame whereby the axis of rotation of said spool is transverse to said longitudinally extending fishing rod when said frame is mounted on said fishing rod, said spool having a line-holding channel of a substantially rectangular cross-section said channel cross-section being narrower than its depth, said channel being positioned in the center of said transverse axis of said spool for holding a length of fishing line therein;

- d) a ring-shaped line guide mounted on said frame in a fixed position forward of said spool and at a point in line with the center of said transverse axis of said spool for positioning said fishing line onto said channel of said spool;
- e) means for releasing said spool and thereby allowing said spool to revolve during the casting of a fishing lure and thereby dispensing fishing line from said line-holding channel; and
- f) means for revolving said spool during retrieval of said line and thereby coiling said fishing line onto said line-holding channel.

22. The fishing reel according to claim 21 wherein, the vertical mid-point of said ring-shaped line guide is positioned so as to be no lower than approximately the vertical mid-point of said line-holding channel and no higher than approximately the top rim of said line-holding channel.

23. The fishing reel according to claim 22 wherein, said ring-shaped line guide is substantially circular.

24. The fishing reel according to claim 23 wherein, the diameter of said substantially circular ring-shaped line guide is in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of said channel.

25. The fishing reel according to claim 24 wherein, said line guide ring is a vertically extending elongated ring.

26. The fishing reel according to claim 25, with the width of said elongated line guide ring is in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the said rectangular channel and the length of said elongated line guide ring is in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the depth of said channel.